



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,328	04/25/2005	Klaus Cichutek	GRUND-101	6255
2387	7590	05/01/2009	EXAMINER	
Olson & Cepuritis, LTD. 20 NORTH WACKER DRIVE 36TH FLOOR CHICAGO, IL 60606			MARVICH, MARIA	
ART UNIT	PAPER NUMBER			
1633			MAIL DATE	DELIVERY MODE
			05/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/510,328	Applicant(s) CICHUTEK ET AL.
	Examiner MARIA B. MARVICH	Art Unit 1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 January 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4,6-9,11-15,18 and 19 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,4,6,9,11,14,15,18 and 19 is/are rejected.
 7) Claim(s) 7,8,12 and 13 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 10/18/07 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 4, 6-9, 11-15, 18 and 19 are pending in this application. This office action is in response to an amendment filed 8/18/08.

Claim Objections

Claims 1 and 18 are objected to because of the following informalities: in claim 1, the phrase "and which is capable" does not indicate what is capable. It would be remedial to recite -- wherein the vector is capable--. This amendment is recommended for claim 18.

In claim 18, the phrase "including an inactive SIVsmmPBj1.9 env gene that includes a deletion" is awkward as it is not clear what constitutes an inactive gene. It would be remedial to amend the phrase to --including a SIVsmmPBj1.9 env gene with a deletion--.

Appropriate correction is required.

Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 is drawn to a pseudotyped vector and hence it appears applicants inherently intend for the vector to comprise a non SIVsmmPBj14 envelope gene under control of a promoter. Claim 6 thus appears to recite limitations inherently intended to be required of claim 1.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6, 9, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stephens et al (J Virology, 1998, Vol 71(6), pages 5207-5214; see entire document). **This is a new rejection.**

Stephens et al teach a pseudotyped vector “derived” from SIVsmmPBj14 as a vector derived from SIVsmmPBj14 is not limited in the number of steps or derivations it must be related. The SHIV vector comprises a heterologous envelope of SIVppc. The vector comprises a SIVsmmPBj14 genome with at least a deletion of the envelope gene as other regions are also “deleted”. The envelope gene is from that of SIVppc under control of a promoter (see figure 1).

Claims 18 and 19 rejected under 35 U.S.C. 102(a) as being anticipated by Manrique et al (Virology, 2004, Vol 329, pages 157-167; see entire document). **This is a new rejection.**

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Manrique et al teach an FIV vector comprising a SIVpbj1/9 genome with an inactive env gene (see e.g. figure 1). Manrique et al teach use of 293T cells (see page 159, col 1 , ¶ 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6, 9, 11, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens et al (J Virology, 1998, Vol 71(6), pages 5207-5214; see entire document) in view of Manrique et al (Virology, 2004, Vol 329, pages 157-167; see entire document).

Applicants claim a method of producing pseudotyped vectors wherein the vector is grown in 293T cells.

The teachings of Stephens et al are described above and are applied as before except Stephens et al do not teach use of 293T cells.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use 293T cells as taught by Manrique et al in the methods of producing the virus of Stephens et al because Manrique et al teach that it is within the ordinary skill of the art to produce SIVsmm virus in 293T cells. The combination of Manrique et al and Stephens et al thus demonstrates an attempt to use known techniques to produce similar viruses using skill that was available at the time of filing with well-established methods. One would have been motivated to do so in order to receive the expected benefit of. Based upon the teachings of the cited references, the high skill of one of ordinary skill in the art, and absent evidence to the contrary, there would have been a reasonable expectation of success to result in the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIA B. MARVICH whose telephone number is (571)272-0774. The examiner can normally be reached on M-F (7:00-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach, PhD can be reached on (571)-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Maria B Marvich, PhD
Primary Examiner
Art Unit 1633

/Maria B Marvich/
Primary Examiner, Art Unit 1633